

**REMARKS**

The Office Action mailed August 23, 2005 has been carefully considered. Within the Office Action Claims 38-57 have been rejected. The Applicant has amended Claims 42, 47, 49, 50, 53 and 55-57 for reasons not associated with patentability of the claims in light of the cited references. The Applicant has also added new dependent Claim 58. Reconsideration in view of the following remarks is respectfully requested.

**Rejection under 35 U.S.C. § 103**

Claims 38, 39, 43, 47-49 and 55 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over JP Publication No. 08-324194 to Sasaki (hereinafter "Sasaki") in view of U.S. Patent No. 5,177,472 to Taniishi et al. (hereinafter "Taniishi"). This rejection is respectfully traversed.

Specifically, the Office Action contends that the elements of the presently claimed invention are disclosed in Sasaki except that Sasaki does not disclose anything which provides coordinate position of the pen. The Office Action further contends that Taniishi discloses a system in which the coordinates of the pen are determined by a vibration transmitting plate according to transmission times. It is thus contended in the Office Action that and that it would be obvious to one having ordinary skill in the art at the time of the invention to replace the work piece in Sasaki with the vibration transmitting plate of Taniishi in order to reach the present invention(s). The Applicant respectfully disagrees for the reasons set forth below.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.

See M.P.E.P. 2141. In addition, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. See M.P.E.P. 2141.02; See also *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

The Applicant has enclosed a translated copy of the Sasaki reference from the Japanese Patent Office website in the accompanying Information Disclosure Statement and refers to the translated copy in the present response.

Sasaki expressly states that the invention is directed to an oscillating pen of a linear drive which is used in sculpturing on the surface of a work piece. (Sasaki, Paragraph 0001). Furthermore, Sasaki specifically discloses that when Current I- is applied to the coil 21, the shaft 18 moves downward, whereby the dead weight 18 collides with the head 24b of the stylus 24 to move the stylus 24 downward. (Sasaki, Paragraph 0034). When moved downward, the pointed end of the stylus 24 collides with the work piece 9 to form an irreversible deformation 9a in the work piece. (Sasaki, Paragraph 0034).

In contrast, Taniishi discloses a vibration transmitting plate 8 which is placed over a display, whereby the plate 8 transmits vibrations from a vibrating input pen 3 to three vibration sensors 6 positioned at corner portions of the plate 8. The vibration sensors 6 measure transmission times of the ultrasonic vibrations transmitted from the vibrating input pen 3 to determine the coordinates of the vibrating input pen 3 on the plate 8.

One skilled in the art would have no motivation to combine Sasaki with Taniishi to reach the present invention. As stated, the pen in Sasaki deforms the work piece when the pointed end of the stylus collides with the surface of the work piece. Utilizing the pen from Sasaki with the vibration transmitting plate 8 would damage the vibration transmitting plate 8, thereby rendering the plate 8 in Taniishi inoperable and unable to perform its intended purpose. See M.P.E.P. 2143.01; 2145 (“proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference”). Therefore, Sasaki and Taniishi teach away from each other and cannot be combined to reach the present invention(s) in Claims 38, 49 and 55. For at least these reasons, Independent Claims 38, 49 and 55 are allowable over Sasaki and Taniishi individually or in combination.

Claims 39, 43, 47, and 48 have also been rejected in light of Sasaki in view of Taniishi. However, Claims 39, 43, 47, and 48 are dependent on Independent Claim 38. As stated above, Claim 38 is allowable over Sasaki and Taniishi individually or in combination. Accordingly, Claims 39, 43, 47, and 48 are allowable for being dependent on an allowable base claim.

Claims 40, 41, 42, 44-46, 50-54, 56 and 57 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Sasaki in view of Taniishi and further in view of U.S. Patent No. 5,627,348 to Berkson et al. (hereinafter “Berkson”). However, Claims 40, 41, 42, 44-46, 50-54, 56 and 57 are dependent on Independent Claims 38, 39 and 55, respectively. As stated above, Claims 38, 39 and 55 are allowable over Sasaki and Taniishi individually or in combination. Accordingly, Claims 40, 41, 42, 44-46, 50-54, 56 and 57 are allowable for being dependent on allowable base claims.

Conclusion

It is believed that the present application is in condition for allowance and early favorable consideration of this Amendment is earnestly solicited. If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,

THELEN REID & PRIEST, LLP

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Suvashis Bhattacharya  
Reg. No. 46,554

Thelen Reid & Priest LLP  
P.O. Box 640640  
San Jose, CA 95164-0640  
Tel. (408) 292-5800  
Fax. (408) 287-8040